

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. Appln. No. 10/663,685
Attorney Docket No.: Q77511

AMENDMENTS TO THE DRAWINGS

Figure 1 is amended to illustrate an exemplary member with a sliding property.

Attachment: One (1) Annotated Marked-Up Drawing

REMARKS

Claims 1-16 are all the claims pending in the Application. By this Amendment, Applicant amends claims 1, 3, 6, 7, 10, 11, and 12. By this Amendment, Applicant editorially amends claims 1 and 41. The amendments to claims 1, 3, 6, and 12 were made to further clarify the invention. The amendments to claims 7, 10, and 11 were made for reasons of precision of language and consistency, and do not narrow the literal scope of the claims and thus do not implicate an estoppel in the application of the doctrine of equivalents.

I. Summary of the Office Action

The Examiner objected to the drawing and the specification. The Examiner maintained the rejection of claims 3-5, rejected claims 1 and 2 on new grounds, and also rejected the previously added claims 6-16.

II. Objection to the Drawings

The Examiner has accepted the replacement drawings filed on July 25, 2005.

The Examiner, however, issued new objections to the drawings. Specifically, the Examiner requests that the member set forth in claims 13 and 15 be depicted in the Figures. Applicant amends Fig. 1 to illustrate the claimed member. Applicant also amends the specification to describe the newly added element. In view of these amendments, Applicant respectfully requests the Examiner to withdraw this objection to the drawings.

III. Objection to the Specification

The Examiner also objected to the specification. Specifically, the Examiner alleges that the title is non-descriptive. Applicant amends the title and respectfully requests that the Examiner withdraw this objection in view of this self-explanatory amendment to the title.

IV. Claim Rejections under 35 U.S.C. § 112, second paragraph

Claims 6, 7, and 10-12 are rejected under 35 U.S.C. § 112, second paragraph. In particular, the Examiner alleges that there are antecedent basis problems in the claims (*see* page 3 of the Office Action). Applicant respectfully traverses these grounds of rejection in view of the following comments.

The Examiner alleges that “said top surface” in claims 6 and 7 lacks proper antecedent basis. This is legally inaccurate as inherent components of elements recited have antecedent basis in the recitation of the components themselves. MPEP § 2173.05(e). For example, the limitation “the outer surface of said sphere” would not require an antecedent recitation that the sphere has an outer surface. See *Bose Corp. v. JBL, Inc.*, 274 F.3d 1354, 1359, 61 USPQ2d 1216, 1218-19 (Fed. Cir 2001) (holding that recitation of “an ellipse” provided antecedent basis for “an ellipse having a major diameter” because “[t]here can be no dispute that mathematically an inherent characteristic of an ellipse is a major diameter”). Inherently, a center core will have a top surface. Accordingly, the antecedent basis for the “top surface” are proper.

With respect to “the magnetic medium” recited in claim 7 and “the outer diameter b” and “the inner diameter c” recited in claims 10 and 11 and “the lower dust-removing liner” recited in claim 12, Applicant amends claims 7, 10, 11, and 12 and respectfully requests that the Examiner withdraw this rejection in view of these self-explanatory claim amendments.

V. Claim Rejections under 35 U.S.C. § 102(b)

Claims 3-6 are rejected under 35 U.S.C. § 102(b). Specifically, the Examiner maintained the rejection of claims 3-5 as being anticipated by U.S. Patent No. 6,433,963 to Meguro et al. (hereinafter “Meguro”) and rejected the previously added claim 6 as being anticipated by

Meguro. Applicant respectfully traverses these grounds of rejection in view of the following comments.

Claim 3, among a number of unique features, recites: “wherein the large-diameter portion is always in contact with an interior lower surface of the shell.” The Examiner alleges that Meguro’s flange portion 14 anticipates the large-diameter portion set forth in claim 3. Applicant respectfully disagrees.

In Meguro, the center hub 11 is adapted to rest on a disc table 9 of a disc rotating driving mechanism and is mounted with an adhesive layer 12 in the center aperture 8 of the flexible magnetic disc 5. The center hub 11 is formed of a magnetic metal material and includes a substantially cylindrical center portion 13, adapted to rest on the disc table 9, and a flange portion 14, formed integrally with the outer periphery of the center portion 13 and which is adapted for being fitted on the inner rim of the center opening 8 of the flexible magnetic disc 5. The center portion 13 of the center hub 11 is formed integrally with an engagement recess 17 engaged by an engagement projection 16 formed on the disc table 9 of the disc drive device (Figs. 2 and 3; col. 3, lines 50 to 63).

Meguro further discloses that during handling, the flexible magnetic disc 5 of the disc cartridge 1 is moved in a direction of the lower plate 22, so that the flange 14 of the center hub 11 rests on the inner surface of the lower plate 22, as shown in FIG. 19. Alternatively, the flexible magnetic disc 5 of the disc cartridge 1 is moved in a direction of the upper plate 21, so that the mid portion 13 of the center hub 11 compresses against the inner surface of the upper plate 21, as shown in FIG. 20 (col. 10, lines 44 to 53).

That is, in Meguro, the flange 14 (alleged large-diameter portion) is moved from and to the upper or lower plate. In other words, Meguro fails to disclose the flange 14 remaining in the same place and not moving. In short, Meguro fails to disclose the large-diameter portion always being in contact with an interior lower surface of the shell (e.g., Figs. 3 and 20). For at least this exemplary reason, claim 3 is patentably distinguishable from Meguro. It is appropriate and necessary for the Examiner to withdraw this rejection of claim 3 and its dependent claims 4-6. Claims 4-6 are patentable at least by virtue of its dependency.

In addition, dependent claim 6 recites: “wherein... said entire top surface of said center core is substantially straight, and the disk medium is fixedly attached to the top-most surface of the center core.” In Meguro, however, the disc 5 is mounted on an adhesive layer 12 only on top of the flange 14 of the center hub 11 but below the top of the mid portion 13 (Fig. 3; col. 3, lines 50 to 64). The top surface of the center hub 11 formed by mid portion 13, however, abuts the upper plate 22 of the cartridge 6 (Fig. 20, col. 10, lines 35 to 44). That is, in Meguro, the disc 5 is not mounted above the top surface of the central hub 11 but rather only on top of the flange portion 14. In other words, Meguro fails to teach or suggest having the disc 5 fixedly attach to the top-most surface of the center hub 11. In short, in Meguro, the disk 5 is not disposed on top of the middle portion 13 of the center hub 11, which is the top-most surface of the center hub 11.

Moreover, in Meguro, the central hub 11 has the flange 14 and the mid portion 13. Accordingly, the top surface of the central hub 11 includes the top surface of the flange 14 and the top surface of the mid portion 13. As such, the entire top surface of the central hub 11 is not substantially straight but is curved to connect the flange 14 to the mid portion 13. In other words, Meguro does not disclose said entire top surface of said center core being substantially

straight and having the disk medium being fixedly attached to the top-most surface of the center core. For at least these additional reasons, claim 6 patentably distinguishes from Meguro.

VI. Rejections under 35 U.S.C. § 103

Claims 1-3 and 6-16 are rejected under 35 U.S.C. § 103(a). Applicant respectfully traverses these rejections in view of the following comments.

A. Claims 12-16

Claims 12-16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Meguro. It was already demonstrated that Meguro does not disclose all of the unique features of claim 3. Accordingly, claims 12-16 are patentable at least by virtue of their dependency on claim 3.

Moreover, the Examiner alleges that the features of claims 12-16 are not disclosed by Meguro. The Examiner, however, takes Official Notices that these features are notoriously known in the prior art. Applicant respectfully challenges these Official Notices in view of the following comments.

These Official Notices are being challenged. The Examiner is respectfully requested to provide references for the allegedly well known features, as well as motivation to combine the references with Meguro.

From the tenor of the grounds of this rejection, it would appear that the Examiner has decided, even though no anticipatory or particularly relevant reference has been found, that the present invention is too simple to be deserving of a patent. As a result, the Examiner has formulated grounds of rejection which, at first blush, appear to be based on actual prior art disclosure, but instead are based on a hindsight rationale that one of ordinary skill in the art, in theory, could have developed the claimed disk cartridge. "Official Notices are taken of the fact

that: a) it is notoriously old and well known in the disk cartridge art to modify the parameters of disk cartridge components during the course of routine optimization/experimentation, b) the member set forth in claims 13-16 is notoriously well known, and c) the ranges set forth in claim 12 can be accomplished in the course of routine experimentation (*see* pages 6-7 of the Office Action).

There are several reasons why, on the present record, the Patent Office can, and indeed must, grant such a patent. First, as noted in MPEP § 2141, “[o]ffice policy has consistently been to follow Graham v. John Deere Co. in the consideration and determination of obviousness under 35 U.S.C. § 103.” Grounds of rejection based on a rationale such as the one just described distort each of the Graham factual inquiries, and produce a distorted determination as a result. Since **the rationale is not rooted in actual prior art**, productive discussion regarding the true scope and content of the prior art is no longer feasible. This, in turn, renders it impossible to clearly ascertain the actual differences between the prior art and the claims at issue.

Second, since the rationale is a purely hypothetical construct, it is by its very nature a creature of hindsight, which makes any advance over the art appear trivial.

Third, the rationale is simply unworkable for effectively and objectively administering patent rights. In effect, such rationale would be the death of any claimed device comprising of a combination of known components. If the Examiner’s technique for rejecting claims were permitted generally, all devices would be found “disclosed” in prior art so long as they could hypothetically be made using known components.

Fourth, MPEP § 2143.01 IV explicitly states that:

A statement that modifications of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art”

at the time the claimed invention was made” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levensgood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000) (Court reversed obviousness rejection involving technologically simple concept because there was no finding as to the principle or specific understanding within the knowledge of a skilled artisan that would have motivated the skilled artisan to make the claimed invention); *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide the suggestion to combine references.).

Examiner’s speculations that the elements are well known and that one would include these allegedly well known elements into the cartridge of Meguro are not objective reasons as they are not rooted in the prior art.

Moreover, most if not all inventions arise from a combination of old elements. *In re Kotzab*, 55 USPQ2d at 1316 (citing *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *Id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. *In re Kotzab*, 55 USPQ2d at 1316 (citing *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); and *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)).

In short, the mere fact that a certain feature could, hypothetically, be included with the cartridge of Meguro does not render the combination obvious, MPEP § 2143.01 III. The Examiner, however, has not cited to *any reference* in support of why one skilled in the art would have been provided with the alleged suggestion and motivation to modify Meguro. It is respectfully noted that, as set forth in MPEP §2143.01, “[t]he level of skill in the art cannot be relied upon to provide the *suggestion* to combine references.” (emphasis added). Accordingly, these Official Notices are challenged and it is respectfully requested that the Examiner allow these claims or provide rejections grounded in the prior art references for these allegedly well known features.

B. Claims 1-3 and 6-11

Next, claims 1-3 and 6-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicant’s Admitted Prior Art of FIGS. 3 and 4 (hereinafter “APA”) in view of Meguro. Applicant respectfully traverses these grounds of rejection in view of the following comments.

Again, the Examiner takes an Official Notice that certain parameters set forth in the claims are well known (*see* page 10 of the Office Action). This Official Notice is challenged (at least for the reasons set forth above) and the Examiner is respectfully requested to withdraw this rejection or to provide references to substantiate the Examiner’s allegations that certain features are well known.

Moreover, the Examiner alleges that one of ordinary skill in the art would have been motivated to incorporate Meguro’s flange portion 14 (alleged large-diameter area) with the APA’s cartridge in order to limit disk movement during handling (*see* page 10 of the Office Action). Applicant respectfully disagrees.

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. Appln. No. 10/663,685
Attorney Docket No.: Q77511

The APA discloses a press plate 6, which holds the disk in place. That is, one of ordinary skill in the art would not have been motivated to also include the flange 14 in order to limit the movement of the disk.

Moreover, at the very least, it is unclear, how the thickness of the flange 14 would limit the movement of the disk. That is, it is respectfully noted that the thickness of the flange is unrelated to the movement of the disk. Accordingly, there is no motivation to combine the references in the manner suggested by the Examiner.

Furthermore, the APA fails to teach or suggest the large diameter portion, as acknowledged by the Examiner (*see* page 9 of the Office Action). Meguro does not cure the deficient teachings of the APA. In Meguro, the flange 14 (alleged large diameter portion) does not form the top-most surface of the center core 11. In other words, taken alone or in any conceivable combination, the combined teachings of the APA and Meguro fail to teach or suggest “an entire top-most surface of the large-diameter portion forms an entire top-most surface of the center core.” For at least these exemplary reasons, claim 1 is patentable over the combined teachings of the APA and Meguro. Claims 2, 3, and 6-11 are patentable at least by virtue of their dependency.

Moreover, dependent claims 2, 3, and 6-11 recite at least some unique features that provide separate basis for patentability. As such, the Official Notice with respect to these dependent claims is challenged and the Examiner is respectfully requested to withdraw this rejection or provide references supporting the Examiner’s allegations.

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. Appln. No. 10/663,685
Attorney Docket No.: Q77511

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

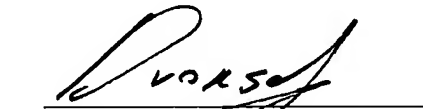
Respectfully submitted,

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER


Nataliya Dvorson
Registration No. 56,616

Date: January 5, 2006

Attorney Docket No.: Q77511

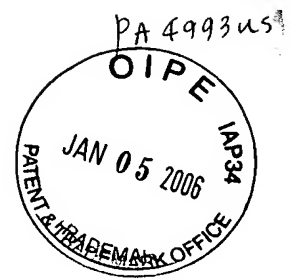


FIG.1

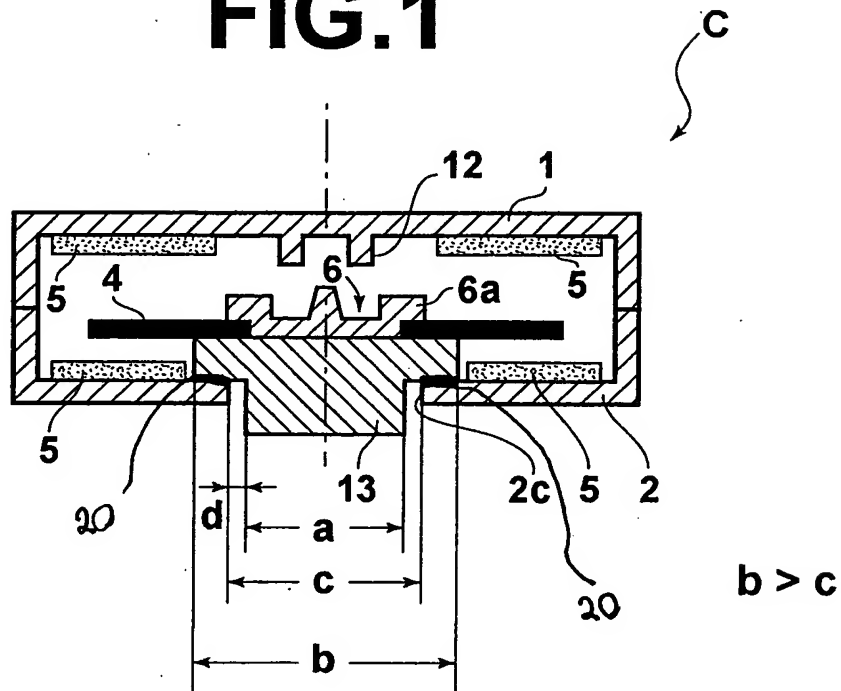


FIG.2

